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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,024	08/20/2003	Peter Joseph Hollands	0142-0442P	5340

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,024

Applicant(s)

HOLLANDS ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/079,556.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The first line of the specification needs to be updated to reflect that the parent application, U.S. Ser. No. 10/079,556, has issued as U.S. Pat. No. 6,673,299.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane, Jr. (U.S. Pat. No. 4,035,462).

Lane discloses a mold and method for making an article. The mold comprises first and second dies (10) which define a mold cavity in which the product is molded (cl. 2, ll. 33-36). The dies are separable from one another in order to remove the molded product (cl. 2, ll. 36-38).

Lane notes that the mold is preferably made of aluminum having a wall thickness of about 1/2 inch (cl. 3, ll. 15-17). Lane also notes that the molded products can have a diameter of 14 inches. As the product is formed into the shape of the mold cavity, the mold cavity thus must have a diameter of approximately 14 inches as well. Therefore the dies have a wall

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thickness (1/2 inch) which is smaller than one-half the average diameter (14 inches) of the mold cavity.

Lane further notes that the mold is heated (cl. 3, ll. 40-52). Thus, the mold has a heating means operatively associated with the dies.

It is noted that the recitation that the mold of claim 1 is "for manufacturing pellets of hot-melt ink" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, it is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In this particular case, the phrase "for manufacturing pellets of hot-melt ink" only reflects an intended use of the claimed apparatus, and is therefore not germane to the issue of patentability.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Savage (U.S. Pat. No. 4,812,323).

Savage discloses a mold in the form a baking sheet to shape products such as cookies. In the embodiment depicted in Figure 6, the device includes first and second dies (32 and 33) defining a cavity (55). The dies are essentially cup-shaped, constructed from aluminum, and have a thickness of 0.16 cm (cl. 7, ll. 27-30). As shown in Figure 5, the wall thickness is smaller than one-half the average diameter of the mold cavity. Savage further discloses the molds to be used with a means for providing hot air against the outer surfaces of the dies (cl. 8, ll. 40-59).

Note, as described above in the rejection in view of Lane, the recited intended use of the claimed mold of the instant application as for manufacturing pellets of hot-melt ink is not germane to the issue of the claimed mold.

5. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hadden (U.S. Pat. No. 3,640,081).

Hadden discloses a molding device. The device comprises first and second dies (2 and 4) defining a mold cavity (cl. 3, ll. 31 and 32). As shown in Figures 3 and 4, the wall thickness

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of the dies is smaller than one-half the average diameter of the mold cavity.

Note, as described above in the rejection in view of Lane, the recited intended use of the claimed mold of the instant application as for manufacturing pellets of hot-melt ink is not germane to the issue of the claimed mold.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadden in view of Lane.

Hadden discloses the molding apparatus as described above. Hadden further discloses the apparatus to be provided with runner holes (16) communicating with the mold cavity for introducing blown air into the mold cavity (cl. 3, ll. 41-44)..

Hadden does not disclose the particular material from which the dies are constructed. However, materials such as metals are well known for the construction of molding devices. For example, Lane discloses aluminum as a molding material (cl. 3, ll. 15-17). Therefore, it would have been obvious to one of

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ordinary skill in the art at the time of Applicants' invention to have used a metal such as aluminum for construction of the dies disclosed by Hadden because metals such as aluminum are well known for the construction of molding dies, and further evidence by the use of aluminum for molds by Lane.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

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Donald Heckenberg
A.U. 1722